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| 10/500,518 | 03/01/2005 | Norbert Heske | 289-PDD-03-07 US | 6401 |
| 96000 | 7590 | 01/06/2011 | EXAMINER | |
| C. R. Bard, Inc. Bard Biopsy Systems 1415 W. 3rd St. Tempe, AZ 85281 | | | LLOYD, EMILY M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3736 | |
| | | | NOTIFICATION DATE | DELIVERY MODE |
| | | | 01/06/2011 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/500,518

Applicant(s)

HESKE ET AL.

Examiner

EMILY M. LLOYD

Art Unit

3736

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 December 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The amendments to claims 57 and 98 require further search and consideration as the limitations removed broaden the scope of the claims and also change the scope of dependent claims 66-68, 99 and 100. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 57,66-68 and 98-104.

Claim(s) withdrawn from consideration: 58-65,69-80 and 92-97.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Max Hindenburg/
Supervisory Patent Examiner, Art Unit 3736

Emily M Lloyd
Examiner
Art Unit: 3736

Continuation of 11. does NOT place the application in condition for allowance because: Regarding Applicant's arguments regarding the IDS of 6 July 2010, the Examiner is not charged with understanding Applicant's intent. Applicant is charged with conveying Applicant's intent clearly to the Examiner. Therefore, if Applicant does not clearly convey the intent, the Examiner is left to not consider the reference or to make a guess as to Applicant's intent. The Examiner made an educated guess of Applicant's intent given the information and time available; further, this educated guess was the patent number provided by Applicant. The Examiner notes that US Patent 33258 (entered as 0033258 by Applicant) is different than US Patent RE33258 (which Applicant did not enter). Simply because the Examiner's attempt to help Applicant was not Applicant's intent (which corresponds to a patent number that Applicant did NOT cite) does not mean that the Examiner is at fault. Any consideration of references not previously considered should be made through an appropriate IDS citing the correct patent number(s) as well as other appropriate information as described in the MPEP.

Regarding Applicant's arguments (pages 12-13) regarding the Naslund reference individually, the Examiner notes that "in the housing" used by the Examiner is different than the "within the housing" used by the Examiner in explaining what the reference does not explicitly teach; further, Applicant's arguments are, as the Examiner previously stated, drawn to arguing that Naslund does not have a feature that is taught by the combination of references used (see especially "Gregoire et al. teach that the biopsy needle carried is contained within the housing" (page 5 of the 7 October 2010 Office Action) and "Dejter, Jr et al. teach that the pressure source is contained within the housing" (page 6 of the 7 October 2010 Office Action)). The Examiner notes that definitions of "in" include "to or toward the inside" and "to or at an appropriate place"; the Examiner further notes that "contained in" is used in claim 101, as such, it appears that "in" is different than "contained in" (as otherwise "contained" would not further limit "contained in").

Regarding Applicant's arguments regarding the Examiner's Official Notice, the Examiner first notes that the arguments are untimely (see MPEP 2144.03 B and C). The Examiner further notes that Applicant's arguments still do not "adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well known in the art." (MPEP 2144.03 C). The Examiner notes that Applicant has previously argued the CAPABILITY of "instant and unquestionable demonstration" of the limitations now considered admitted prior art. The Examiner notes that something having the CAPABILITY to do something is present regardless of the time the capability is presented; for example, a laptop has the CAPABILITY to hold down a piece of paper like a paperweight, regardless of if the drawing showing this capability is from 10 years ago or today. Applicant's argument that the Official Notice was not CAPABLE of "instant and unquestionable demonstration as being well-known" is not persuasive because, just like the laptop with the piece of paper, this CAPABILITY is present. Further, the Examiner notes that that Applicant has not stated "why the noticed fact is not considered to be common knowledge or well known in the art" (MPEP 2144.03 C); Applicant has only argued that what is capable of "instant and unquestionable demonstration" in Applicant's application was not capable of the same "instant and unquestionable demonstration" prior to Applicant's application (without explaining how Applicant can be capable of something but prior art cannot be capable of it). The Examiner notes that without stating "why the noticed fact is not considered to be common knowledge or well known in the art" (MPEP 2144.03 C), Applicant's traversal is further inadequate and therefore "the common knowledge or well-known in the art statement is taken to be admitted prior art because ... the traverse was inadequate." (MPEP 2144.03 C).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).